

## REMARKS

Reconsideration of this application is respectfully requested.

### **35 USC § 102 Rejection**

The claims are patentable over Hamada et al., U.S. Patent No. 5,581,544 ("Hamada") under 35 U.S.C. § 102 as follows. Hamada provides a scheme for reducing variations in call loss rates among queues (e.g., priority classes). Hamada suggests that the QOS of each priority class (in the priority control scheme) depends on the buffer amount assigned to each priority class. Hamada further suggests that the call loss rate of each priority class depends on the assigned buffer amount. (col 11, 11.59-62). Moreover, Hamada asserts that the QOS of a priority class after changing the assigned buffer amount can be predicted by calculation. Thus, Hamada provides that the buffer amount based on the prediction, variations in call loss rate among priority classes can be suppressed to optimize the buffer amount allocation. Hamada's Figure 4 further explains this buffer optimization process.

However, Hamada does not teach or suggest temporarily increasing a buffer size for a router configured to receive packets transmitted through a communication network at a time instant corresponding to an onset of congestion of the router for a time period. Indeed, as explained, Hamada is merely concerned with reducing variations in call loss rates among queues. Applicants claim 1 provides for temporarily increasing a buffer size for a router configured to receive packets transmitted through a communication network at a time instant corresponding to an onset of congestion of the router for a time period. Therefore, claim 1 is patentable over Hamada under 35 U.S.C. § 102.

### **35 USC § 103 Rejection**

The claims are patentable over Hamada in view of Eng et al., U.S. Patent No. 5,457,679. under 35 U.S.C. § 103 as follows. As explained above Hamada does not teach or suggest temporarily increasing a buffer size for a router configured to receive packets

transmitted through a communication network at a time instant corresponding to an onset of congestion of the router for a time period.

Even adding the teachings of Eng does not render the present invention obvious. Eng provides a scheme for channel sharing and memory sharing in a packet switching apparatus. Indeed, the Examiner does not even rely on Eng for temporarily increasing buffer size for a router configured to receive packets transmitted through a communication network at a time instant corresponding to an onset of congestion of the router for a time period. Accordingly, the claims are patentable over the combination of Hamada and Eng.

Jain et al., U.S. Patent No. 5,193,151 ("Jain") fails to cure these deficiencies. Jain merely teaches a network congestion avoidance scheme in which each network node measures the round-trip delay occurring when it sends data to a destination and receives an acknowledgement. This delay is measured for different load levels, and a comparison of these delays is used to determine whether to increase or decrease the load level. The load level can be changed by adjusting a network tuning parameter such as the window size (number of packets sent in to the network) or the packet rate (packets per unit time). However, Jain does not teach or suggest temporarily increasing a buffer size for a router configured to receive packets transmitted through a communication network at a time instant corresponding to an onset of congestion of the router for a time period. Accordingly, the claims are patentable over the combination of Hamada, Eng, and Jain.

The combination of these references themselves are also suspect. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention in which there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). The Office Action indicates that the references cannot be argued individually when cited in combination, but fails to recognize that such combinations are themselves improper when no motivation for the combination is shown. Indeed, rather than show any reasons for the recited combinations, it appears the teachings of the present

application have been used as a blueprint to gather together and assemble various components of the prior art in the manner contemplated by the present applicant. This approach is a classic example of the use of hindsight reconstruction and cannot properly be used as grounds for rejecting the present claims.

The U.S. Court of Appeals for the Federal Circuit has strongly criticized such use of hindsight by specifically indicating that when an obviousness determination is made based upon a combination of references, even a patent examiner "must show reasons that the skilled artisan, confronted with the same problems as the inventor *and with no knowledge of the claimed invention*, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (Emphasis added). The Examiner merely arguing in his Office Action of June 10, 2002 that the claimed invention would be obvious to one of ordinary skill in the art based on the combination of the references is utterly inadequate. *Rouffet*, at 1357. Instead, a motivation, either from the references themselves or the knowledge of those of ordinary skill in the art, for the combination being relied upon needs to be shown. *Rouffet*, at 1357.

In the present case, no such motivation has been shown. Instead, the Examiner attempts to deconstruct the subject matter of the claims of the present application into its constituent components. He further states where each such component may be found in one of the cited references and then concludes that it would have been obvious to combine the references to arrive at the claimed invention. This bare bones analysis is not sufficient to support a determination of obviousness of the present application. The burden is on the Examiner to show *why* one skilled in the art is so motivated as to come up with the combination being relied upon. *Rouffet*, at 1357-1358 ("If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance. Instead, in complex scientific fields [an infringer or the Patent Office] could routinely identify the prior art elements in an application, invoke the lofty level of skill, and rest its case for [obviousness]. To counter this potential weakness in the obviousness construct, the suggestion to combine requirement stands as a critical safeguard against hindsight


analysis and rote application of the legal test for obviousness."). Accordingly, the present rejections under 35 U.S.C. §103(a) should be removed.

If there are any additional charges associated with this communication, please charge Deposit Account No. 02-2666.

Respectfully submitted,  
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Date: Sep 9, 2002

  
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